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JUN 01 2004

In re Application of	:	OFFICE OF PETITIONS
Fritz Kirchhofer et al	:	
Application No. 09/903,297	:	DECISION ON PETITION
Filed: July 11, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 14080	:	AND 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.313(b)(5), filed August 20, 2003, which is being treated as a petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee. This is also a decision on the petition under 37 CFR 1.78(a)(3), filed August 20, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to International Patent Application PCT/CHOO/00017, filed January 11, 2000, which claims priority to German Application 199 00 827.2.

The petitions are **DISMISSED**.

PETITION UNDER 37 CFR 1.313(c)(2)

Turning first to the petition under 37 CFR 1.313(c)(2), unfortunately, the instant petition to withdraw from issue was not received within sufficient time to avert the issuance of the above-identified application into a patent. In this regard, the petition did not reach the deciding official's office until December 23, 2003, which is after the date of issuance of the instant application into Patent No. 6,613,023 on September 2, 2003.

Petitioner's attention is directed to 37 CFR 1.313(d), which states:

A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials **before the date of issue**.

Since a petition to withdraw the instant application from issue was not granted prior to issuance of the instant application into a patent, the request for continued examination (RCE) filed concurrently with the instant petition is improper. Accordingly, the \$770 fee submitted for the RCE will be refunded to petitioner's deposit account in due course.

PETITION UNDER 37 CFR 1.78(a)(3)

As to the petition under 37 CFR 1.78(a)(3), a petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application(s), unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition was accompanied by items (1) through (3) above. However, because the instant application has now issued into a patent, a Certificate of Correction and documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. § 120 priority is appropriate¹ must now be submitted before the petition under 37 CFR 1.78(a)(3) can be granted. *Note* MPEP 1481, page 1400-71 (Aug. 2001).

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, petitioner must comply with the above-noted requirements. Any request for reconsideration of this decision must be included in a Renewed Petition under 37 CFR 1.78(a)(3).

¹ See MPEP 201.13(b) as to the requirements for 35 U.S.C. § 120 priority based on an international application.

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Any questions concerning this matter may be directed to the undersigned at
(703) 305-8680.

The patented file is being forwarded to Files Repository.

A handwritten signature in cursive script, appearing to read "Frances Hicks", is written over the printed name.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy